

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Appreciation is expressed to Examiner Rodriguez for mailing a new Official Action identifying U.S. Patent No. 3,910,156 to *Soltysik* as the reference relied upon in the rejection of Claims 1, 2 and 4-12.

Examiner Rodriguez is also kindly thanked for indicating that Claims 12 and 13 are allowable and that Claims 10 and 11 would be allowable if rewritten in independent form.

It is believed that the rejection set forth in the Official Action based on the disclosure in *Soltysik* may have been based on a less than full appreciation of the claimed invention recited in independent Claim 1 and/or a misunderstanding concerning the disclosure in *Soltysik*. Thus, before addressing the prior art rejection, a brief overview of the subject matter at issue here may be helpful in facilitating a better understanding of the claimed invention at issue here.

The subject matter of this application pertains to a metal spacer. As recited in independent Claim 1 the metal spacer is interposed between the opposed faces of two members having respective bores that are coaxial with each other and fastened to one another through insertion of a fastening member into the bores and tightening the fastening member. The spacer comprises a base interposed between the opposed faces of the members and possessing a through hole that is coaxial with the bores of the respective members so that the fastening member is inserted through the hole. The spacer also comprises a temporarily retaining portion provided on the open edge of the hole of the base for temporarily retaining the

spacer on one of the members before the members are fastened to each other, with the temporarily retaining portion being inserted into the bore of the one member and caught on a wall defining the bore.

Soltysik discloses a screw anchor clip 10 adapted to be positioned in an aperture 12 of a body of material 13 and held in place in the body of material 13 by a number of locking ears 11. A threaded screw or bolt 14 is inserted through an opening 16 of the screw anchor clip. The screw anchor clip also includes an annular collar member 26 defining the aperture 16 that receives the screw or bolt 14, and a pair of spaced apart C-shaped wall portions 27, 28. As discussed in lines 46-53 of column 2 of *Soltysik*, the wall portions 27, 28 are connected to the head end portion 17 by a reduced material portion 37.

The Official Action observes that the locking ears 11 disclosed in *Soltysik* correspond to the claimed temporarily retaining portion 11. However, this position is not consistent with the language in original Claim 1. That is, Claim 1 recites that the temporarily retaining portion of the spacer is provided on the open edge of the hole of the base. That is clearly not the case with the locking ears 11 disclosed in *Soltysik* as can be seen from various ones of the drawing figures in *Soltysik*, including Figs. 1, 3 and 5.

It is noted that the locking ears 11 disclosed in *Soltysik* are provided on the wall portions 27, 28 and so perhaps the rejection of Claim 1 is based on the belief that the wall portions 27, 28 are provided on the open edge of the hole of the base and so it can be said that the locking ears 11 are provided on the open edge of the hole of the base by way of the wall portions 27, 28. However, the wall portions 27, 28 disclosed in *Soltysik* are also not provided on the open edge of the hole of the

base. Rather, as noted above, *Soltysik* states in lines 46-53 of column 2 that the wall portions 27, 28 are connected to the head end portion 17 by the reduced material portion 37. Thus, the wall portions 27, 28 are not provided on the open edge of the hole of the base and so it cannot be said that the locking ears 11 are provided on the open edge of the hole of the base by way of the wall portions 27, 28.

As the Examiner is aware, anticipation under 35 U.S.C. § 102(b) requires disclosure of each and every claimed feature in a single reference. As *Soltysik* does not disclose the temporarily retaining portion provided on the open edge of the hole of the base for temporarily retaining the screw anchor clip, *Soltysik* cannot be said to anticipate the invention defined in independent Claim 1. Thus, withdrawal of the rejection based on the disclosure in *Soltysik* is respectfully requested.

The Official Action also sets forth a rejection of dependent Claim 3 based on the disclosure contained in *Soltysik*. In setting forth this rejection, the Official Action observes that *Soltysik* fails to disclose an insulating coating applied to a surface of the spacer. This subject matter is set forth in dependent Claim 2 rather than Claim 3. In any event, the Official Action observes that it would have been obvious to apply an insulating coating to the surface of the screw anchor clip disclosed in *Soltysik* because insulating coatings are used in applications where electrical insulation is needed. Assuming for the moment that this latter observation is true, it has not been established that the screw anchor clip disclosed in *Soltysik* is used in an environment where electrical insulation is needed and so no basis exists for the conclusion that it would have been obvious to apply an insulating coating to the disclosed screw anchor clip for such purpose.

The Examiner's attention is directed to the Information Disclosure Statement filed on August 31, 2005 disclosing two documents cited in the Search Report of a corresponding foreign application. To more clearly distinguish over the disclosure in Japanese Application Publication No. 2000-27904 disclosing a retainer 10 used in a disc brake, Claim 1 has been amended to include the subject matter recited in Claim 8. Claim 1 thus now recites, in combination with the other claimed features, that the temporarily retaining portion has a pair of projections formed on respective opposite sides of a distal end thereof so that the projections extend in a circumferential direction of the hole of the base. In addition, each projection includes a lower edge that is upwardly inclined when the temporarily retaining portion is inserted into the bore of the one member, with each projection being brought into sliding contact with the open edge of the bore of the one member so that the overall spacer is moved toward the central axis of the bore of the one member. The retainer 10 disclosed in Japanese Application Publication No. 2000-27904 does not include a temporarily retaining portion possessing the features recited in Claim 1. These additional features now set forth in Claim 1 also further distinguish over the disclosure in *Soltysik*.

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful

in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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